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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,056	11/14/2003	Setsuji Tatsumi	08780001AA	9030

7590 09/25/2006

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EXAMINER

TRAN, LY T

ART UNIT	PAPER NUMBER
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2853

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/712,056	Applicant(s) TATSUMI ET AL.	
	Examiner Ly T. TRAN	Art Unit 2853	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.  
     4a) Of the above claim(s) 7-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 7-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention/species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/19/05.
2. Applicant request for the clarification of the requirement for election of species. Applicant argues that there is no reference to the drawing figure for species, therefore, it is not entirely clear what to be the patentably distinct species. This argument is not deemed to be persuasive because the species is not away have to have a different figure.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janosky (EP 1407893) in view of Higuma et al (USPN 6,332,679)

With respect to claims 1-6, Janosky discloses a surface treatment apparatus comprising:

- A sheet heating unit (fig.1, fig.2: element 22) which heats a sheet (14);
- A contact member (fig.2: element 26) for transferring a surface quality thereof to a surface of the image recording layer;
- A sheet cooling unit (fig.2: element 38) which cools the sheet while in contact with the contact member;
- A plurality of contact members (fig.2: element 28, 30, 32, 26) having different surface qualities;
- A contact member selecting unit which selects a contact member having a desired surface quality from the plurality of contact member having a different surface qualities (Column 3: line 41-58);
- The contact member is a member is a member selected from a roller and an endless belt (Fig.2: element 30, 26);
- A surface quality of the contact member is varied so that one of a gloss treatment and a matt treatment is given to the sheet (Column 5: line 3-30);
- A user information providing unit for providing user information containing the contact member surface quality data (Column 4: line 1-3);
- The contact member selecting unit, a desired surface quality if selected based on user information provided by the user information unit (Column 4: line 1-3, Column 6: line 30-37).

However, Janosky fails to teach the sheet having at least a base, a recording layer and a thermoplastic resin layer disposed on the base.

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Higuma teaches the sheet having at least a base and a thermoplastic resin layer disposed on the base (Column 3: line 40-45).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to coat the substrate with a thermoplastic resin layer as taught by Higuma. The motivation of doing so is to provide a permeation property and to prevent retaining much of the inks and color material.

### ***Response to Arguments***

4. Applicant's first arguments filed 6/26/06 have been fully considered but they are not persuasive.

Applicant argues that Janosky fails to teach transferring a surface quality to a surface of the image-recording layer because Janosky apply a plastic laminate over the image. This argument is not deemed to be persuasive because referring to column 4: [0022], Janosky discloses transferring a surface quality to a surface of the image recording layer by the embosser unit. It 's truth that the plastic lamination if over the image recording layer but the embosser unit still transfer a surface quality to the image recording layer with the plastic lamination on it. Furthermore, this is an apparatus claim comprising a contact member for transferring a surface quality to the surface of the image recording layer, not a method claim comprising the step of transferring a surface quality. Since Janosky teaches the same apparatus with an extra step of lamination but

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the final product is the same as the present invention. Therefore, Janosky still meets the limitation of the claim.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ly T. TRAN whose telephone number is 571-272-2155. The examiner can normally be reached on M-F (7:30am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on 571-272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LT

Sept. 13, 2006

  
**MANISH S. SHAH**  
**PRIMARY EXAMINER**